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09/928,677	08/13/2001	Michael Epstein	US 010179	8168

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EXAMINER

TESLOVICH, TAMARA

ART UNIT PAPER NUMBER

2137

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/928,677

Applicant(s)

EPSTEIN, MICHAEL

Examiner

Tamara Teslovich

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed July 7, 2005 have been fully considered but they are not persuasive.

The Applicant argues that Ram et al. neither discloses nor suggests the preprocessor as claimed in claim 1, or the preprocessing step as claimed in claim 12. The Examiner would like to cite page 5 of the Applicant's arguments wherein the Applicant himself states in lines 9-11, "Ram et al. mentions the pre-processing of the rights specification." The Applicant goes on to claim that Ram et al. fails to describe the pre-processing and whether said preprocessing is bring done to conform the rights specification to the defined characteristics of the content material.

The Examiner would like to draw the Applicant's attention first to Figure 6 wherein it is clear that Ram et al. teaches the pre-processing of both the content as well as the rights specifications before combining the two in a Self-Protecting Document ("SPD"). This pre-processing is described in further detail in lines 35-28 of column 9 wherein Ram et al. describes how "the content is essentially 'pre-rendered' in the content pre-processing step so that it will be in a format that is compatible with user's systems and the SPD." Ram et al. goes on to describe in column 11, lines 34-38 wherein "the high-level rights specification is also subject to a pre-processing step, in which the high-level specification is compiled into a more-efficient data structure representation for use by the invention [SPD]." Referring back to Figure 6, or

alternatively column 11, lines 39-46, Ram et al. goes on to suggest the combination of the pre-processed rights along with the pre-processed content into an SPD which is then encrypted before being transmitted.

The abovementioned sections of Ram et al. provide ample support for the Applicant's claimed preprocessing steps. In addition, Ram et al. also teaches in column 3 lines 51-59, column 6 lines 18-33, column 8 lines 45-54, column 9 lines 50-53, and column 13 lines 54-56 wherein both the content and the rights specifications are 'polarized' with a key dependent on the user's system before being placed within in the SPD.

Taking into consideration the abovementioned arguments concerning Ram et al.'s preprocessing of both the rights specifications and the content and the polarization of each with a key dependent on the user's system, it is apparent that Ram et al. intended for the polarization of individual subsections of information within the SPD in conformance with the intended use of the SPD so that the information contained within would remain intact and secure in order to be received and utilized by an authorized end system and user.

In response to applicant's argument that "Ram et al. is not concerned with any effect that post-processing may have on the dissimilarities between the data and the content", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to the Applicant's arguments concerning claims 5 and 16 wherein the Applicant suggests that Ram et al.'s "audio and video clips" and "any other known manner on a variety of media" fail to include the "audio signal" as suggested in the claimed invention, the Examiner would like to respectfully disagree with the Applicant's arguments. It would have been obvious to a person of ordinary skill in the area at the time of the invention to include within the "audio and video clips and any other known manner on a variety of media" as described in Ram et al. the audio signal suggested by the Applicant. As for the Applicant's argument relating to Ram et al.'s failure to mention "noise" relating to the data to be added to the content material, the Examiner would like to bring to the Applicant's attention the stated Prior Art in its entirety, and invites the Applicant to refer back to the previous office actions rejections of the claims in question.

As per the Applicant's arguments relating to claims 7 and 18, the Examiner would like to once again respectfully disagree with the Applicant's declaration that Ram et al. fails to teach the necessary modulation and encode as claimed. Within Ram et al.'s "Background of the Invention", it is clearly shown that Ram et al.'s system is meant for the distribution and transfer of a variety of multimedia to be embodied on a variety of medium and read by a variety of players. In addition, Ram et al. provides ample support for the translation of data from a variety of forms to a secure electronic form would be desirable, and where once received by the intended, it would be desirable to return the media to a form readable by the intended media device (columns 1-3).

Therefore, based on the above arguments, the Examiner maintains the rejections as set forth below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ram et al. (US Patent 6,519,700 B1).

As per claim 1, Ram discloses an encoding system for adding data to encoded content material, the encoded content material ("encrypted content") having defined characteristics, comprising a preprocessor that is configured to encode the data to form encoded data ("encrypted rights and permissions segment") that conforms to the defined characteristics of the encoded content material, and a combiner that is configured to combine the encoded content material and the encoded data to form a combined encoded output ("SPD") that conforms to the defined characteristics of the encoded content material (see Ram col.7 lines 45-60; col.8 lines 23-27; col.11 lines 39-46).

As per claim 2, Ram discloses the encoding system of claim 1, further comprising a postprocessor that is configured to process an input that is consistent with the defined characteristics of the encoded content material ("customized PDF"), and wherein the combined encoded output ("generic SPD") is provided as the input to the postprocessor (see Ram col.11 line 57 thru col.12 line 6).

As per claim 3, Ram discloses the encoding system of claim 2, wherein the postprocessor includes a watermarking system (see Ram col.11 lines 41-46).

As per claim 4, Ram discloses the encoding system of claim 3, wherein the watermarking system is configured to provide at least one of: a fragile watermark and a robust watermark, based on the combined encoded output (see Ram col.11 lines 41-46).

As per claim 5, Ram discloses the encoding system of claim 1, wherein the data ("document") comprises an analog noise signal, and the preprocessor is configured to receive the analog noise signal ("audio and video clips" and "any other known manner on a variety of media") and to produce therefrom the encoded data as a digital encoding (see Ram col.1 lines 31-38).

As per claim 6, Ram discloses the encoding system of claim 5, wherein the analog noise signal is at least one of: an audio noise and a visual noise ("audio and video clips" and "any other known manner on a variety of media") (see Ram col.1 lines 31-38).

As per claim 7, Ram discloses the encoding system of claim 1, wherein

Art Unit: 2137

the data comprises a digital signal ("digital data"), and the preprocessor is configured to receive the digital signal, and includes a modulator ("pre-renderer") that converts the digital signal to an analog signal, and an encoder that processes the analog signal to form the encoded data as a digital encoding (see Ram col.9 lines 35-36, 38-40, 44-48; col.11 lines 34-38).

As per claim 8, Ram discloses the encoding system of claim 7, wherein the encoder is substantially equivalent to a device that provides the encoded content material having the defined characteristics (see Ram col.11 lines 39-41).

As per claim 9, Ram discloses the encoding system of claim 8, wherein the encoder comprises at least one of: a CD encoder and a DVD encoder (see Ram col.1 lines 31-38).

(Please note that although Ram fails to specifically mention the term "CD" or "DVD", it makes reference to "audio and video clips" which are "stored as digital data on a storage medium" (see Ram col.1 lines 31-38). Ram also makes mention of resulting "presentation data immediately suitable for display on a video screen or for other use depending on document type" (see Ram col.5 lines 50-54). See also, Stefik et al. (US Patent 5,715,403) incorporated by reference by Ram, for more details involving CD secure distribution systems.)

As per claim 10, Ram discloses the encoding system of claim 1, wherein the combiner is configured to concatenate the encoded content material and the encoded data to form the combined encoded output ("combine the pre-processed content, the

pre-processed rights specification, and an optional watermark”) (see Ram col.11 lines 39-41).

As per claim 11, Ram discloses the encoding system of claim 1, wherein the encoding system is configured to provide the data, based on a random process (see Ram col.6 lines 34-44).

As per claim 12, Ram discloses an encoding method for adding data to encoded content material, the encoded content material (“encrypted content”) having defined characteristics, comprising preprocessing the data to form encoded data (“encrypted rights and permissions segment”) that conforms to the defined characteristics of the encoded content material, and combining the encoded content material and the encoded data to form a combined encoded output (“SPD”) that conforms to the defined characteristics of the encoded content material (see Ram col.7 lines 45-60; col.8 lines 23-27; col.11 lines 39-46).

As per claim 13, Ram discloses the encoding method of claim 12, further comprising postprocessing the combined encoded output (“generic SPD”) via a process that is compatible with the defined characteristics of the encoded content material (“customized PDF”) (see Ram col.11 line 57 thru col.12 line 6).

As per claim 14, Ram discloses the encoding method of claim 13, wherein the postprocessing includes watermarking the combined encoded output (see Ram col.11 lines 41-46).

As per claim 15, Ram discloses the encoding method of claim 14, wherein the watermarking provides at least one of: a fragile watermark and a robust watermark, based on the combined encoded output (see Ram col.11 lines 41-46).

As per claim 16, Ram discloses the encoding method of claim 12, wherein the data ("document") comprises an analog noise signal, and the preprocessing includes receiving the analog noise signal ("audio and video clips" and "any other known manner on a variety of media") and producing therefrom the encoded data as a digital encoding (see Ram col.1 lines 31-38).

As per claim 17, Ram discloses the encoding method of claim 16, wherein the analog noise signal is at least one of: an audio noise and a visual noise ("audio and video clips" and "any other known manner on a variety of media") (see Ram col.1 lines 31-38).

As per claim 18, Ram discloses the encoding method of claim 12, wherein the data comprises a digital signal ("digital data"), and the preprocessing includes receiving the digital signal, and includes modulating ("pre-rendering") the digital signal to form an analog signal, and encoding the analog signal to form the encoded data as a digital encoding (see Ram col.9 lines 35-36, 38-40, 44-48; col.11 lines 34-38).

As per claim 19, Ram discloses the encoding method of claim 18, wherein the encoding is substantially equivalent to an encoding process that provides the encoded content material having the defined characteristics (see Ram col.11 lines 39-41).

As per claim 20, Ram discloses the encoding method of claim 19, wherein the encoding process corresponds to at least one of: a CD encoding process and a DVD encoding process (see Ram col.1 lines 31-38).

(Please note that although Ram fails to specifically mention the term "CD" or "DVD", it makes reference to "audio and video clips" which are "stored as digital data on a storage medium" (see Ram col.1 lines 31-38). Ram also makes mention of resulting "presentation data immediately suitable for display on a video screen or for other use depending on document type" (see Ram col.5 lines 50-54). See also, Stefik et al. (US Patent 5,715,403) incorporated by reference by Ram, for more details involving CD secure distribution systems.)

As per claim 21, Ram discloses the encoding method of claim 12, wherein the combining includes concatenating the encoded content material and the encoded data to form the combined encoded output ("combine the pre-processed content, the pre-processed rights specification, and an optional watermark") (see Ram col.11 lines 39-41).

As per claim 22, Ram discloses the encoding method of claim 12, further including generating the data based on a random process (see Ram col.6 lines 34-44).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

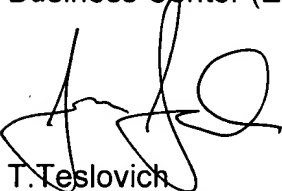
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

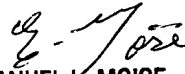
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. Teslovich  
October 10, 2005



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER